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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,197	02/25/2004	Yuki Nakajima	023971-0383	3372
22428	7590	12/16/2008	EXAMINER	
FOLEY AND LARDNER LLP			ALI, MOHAMMAD M	
SUITE 500				
3000 K STREET NW			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20007			3744	
			MAIL DATE	DELIVERY MODE
			12/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/785,197	NAKAJIMA ET AL.	
	Examiner	Art Unit	
	MOHAMMAD M. ALI	3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 September 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "pan reserving the first refrigerant" for claims 1 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim 1 states in the beginning of the last Para that a heat exchanger transferring the heat of the second refrigerant to the first refrigerant and in lines 22-23 the claim 17 states that the first refrigerant passage is disposed inside the second refrigerant passage. From the above it is clear that the first refrigerant is the water and the first refrigerant cools or absorbs the radiated heat of the second refrigerant. Therefore, it is not clear how the first refrigerant reserved in the pan being radiated to the second refrigerant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-17 and 18 are rejected under 35 U.S.C. 103(b) as being unpatentable over Takeshi et al., (EP 1049234 A2) in view of Staffia (5,732,769) and Ashenfelter (4,576,555). Takeshi et al., disclose a drive unit 10 for an electric vehicle comprising a motor M, an inverter H, a speed reducer (see column 8, lines 37-40), a first refrigerant (water) receiving heat of at least one of the motor and the inverter and outputting the heat into the atmosphere through radiator R; second refrigerant (lubricating oil) receiving heat of at least one of motor and the speed reducer and outputting heat to the first refrigerant through a heat exchanger C; the heat exchanger C transferring the heat of second refrigerant to the first refrigerant. See Fig.1, column 6, line 44 to column 9, line 2. Also see Fig. 5, 6,11, 12 and 14; differential drive pinion gear 45, differential ring gear 52 and differential D, see Fig. 3 and Para [0041]; the inverter U as shown in Fig. 5, mount on the part of the drive unit case 10 and integrated with drive unit case 10, see Para [0047] and lines 18-23. Takeshi et al., disclose the invention substantially as claimed as stated above except another cooling passage being disposed inside of the cooling passage through which the second refrigerant is passed and the heat exchanger being disposed at a bottom of the drive unit.. Staffia teaches the a cooling passage between external pipe 1 and internal pipe 2 through which (see arrow 5) a second refrigerant (lubricating oil) is passed and the another refrigerant (cooling water) is passed through the internal pipe 4 disposed inside the second refrigerant passage as shown by arrow 7 in a vehicle oil cooling system for the purpose of cooling lubricating oil

and Ashenfelter teaches the use of a heat exchanging pipe 54 with cool refrigerant exchanging heat with the lube oil in the sump 70 both disposed under a drive unit 20 for the purpose of cooling lubricating oil. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the drive unit of Takeshi et al., in view of Staffia and Ashenfelter such that the passage of other refrigerant could be provided through the passage of a second refrigerant and the heat exchanger being disposed at the bottom of the drive unit in order to exchange heat with the lubricating oil to cool it at a place where it gathers in a sump of a drive unit.

Regarding claims 2-7, 9-11, 14-15 and 18, the specific configuration of inverter and speed reducer; it is an obvious to have a specific configuration of the above objects since there is no criticality or unexpected result from it. Regarding the pan, the Examiner considers the oil sump 70 as shown in Fig. 1 of Ashenfelter is the pan of second refrigerant and the lower inner surface of water passage 54 as the pan of the first refrigerant.

Response to Arguments

Applicant's arguments filed 09/02/08 have been fully considered but they are not persuasive. The applicant argues that in claim 1 the heat exchanger includes a pan reserving the first refrigerant where the heat of the first refrigerant reserved in the pan is radiated to the second refrigerant. The references applied in the rejection of the claims fail to disclose at least this feature of claim1. The Examiner disagrees. The Applicant's above disclosure has been rejected by 112 problems. However, if the first refrigerant is the oil and the pan is the oil pan, Ashenfelter disclose the pan 70 from which radiated

heat is transferred to the refrigerant in the pipe 54. Therefore, Takeshi et al. in view of Ashenfelter disclose the pan for the first refrigerant.

Therefore, references do not disclose the above claimed feature is not correct.

The Applicant further argues that the references applied in rejection fail to suggest the advantages attained by the structure of claim 1. The structure of claim 1, including the pan as recited-----failing to suggest the structure of the pan as recited in claim 1, fail to suggest the advantages resulting therefrom.

The Examiner disagrees. The Examiner depends on the previous answer for this second answer being the similar one.

Therefore, the rejections are ok.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD M. ALI whose telephone number is (571)272-4806. The examiner can normally be reached on maxiflex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J. Tyler can be reached on 571-272-4808. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mohammad M Ali/
Primary Examiner, Art Unit 3744